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EXAMINER

ROSEN, NICHOLAS D

ART UNIT PAPER NUMBER

3625

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/043,856	Applicant(s) POUS ET AL.	
	Examiner Nicholas D. Rosen	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-41 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 11 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-41 have been examined.

Response to Traversal of Official Notice

Applicant has traversed certain (not all) of Examiner's takings of official notice, and requested references to support the teachings, which Examiner hereby provides, specifically:

In rejecting claim 9, Examiner took official notice that it is well known to provide lists of available products in online catalogs. This is supported by Hartman et al. (U.S. Patent 5,960,411), column 1, lines 46-57; and also by Tracy et al. (U.S. Patent 5,979,757), column 14, lines 48-67.

In rejecting claim 15, Examiner took official notice that it is well known for merchants in e-commerce to display lists of available products, stored in a memory, on a visual interface. This is supported by Montoya (U.S. Patent Application Publication 2001/0047292), paragraph [0004] ("display" being taken to imply a visual interface); and also by Fujiwara (U.S. Patent Application Publication 2001/0032149), paragraph 28 ("display" and "viewing" being taken to imply a visual interface).

In rejecting claim 34, and also claim 38, Examiner took official notice that it is well known to have products already assembled and available. This is supported by Tracy et al. (U.S. Patent 5,979,757), column 14, lines 48-67.

In rejecting claim 37, Examiner took official notice that it is well known for transmission over the Internet or an intranet to be electronic transmission. This is

supported by Schneier et al. (U.S. Patent 6,099,408), column 4, lines 37-43; and also by Cohen (U.S. Patent 6,278,963), column 6, lines 15-20.

In rejecting claim 39, Examiner took official notice that it is well known to maintain items in lists. This is supported Hartman et al. (U.S. Patent 5,960,411), column 1, lines 46-57; and also by Tracy et al. (U.S. Patent 5,979,757) column 14, lines 48-67.

The common knowledge or well-known in the art statements in the previous office action which Applicant did not traverse are taken to be admitted prior art, because Applicant did not traverse Examiner's taking of official notice.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1, as amended, recites providing a selector "to select an unavailable product or attribute that is not offered for sale." This is not supported by the specification, which only describes selecting an unavailable product which is not immediately available, but is offered for sale, receipt of the

presently unavailable product to take place after some degree of engineering or development, and after the product is made. Note especially pages 6 and 7.)

Claims 15-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 15, as amended, recites providing a selector "to select one of a product and an attribute that cannot be ordered from the provider." This is not supported by the specification, which only describes selecting a product or attribute which is not immediately available, but which can be ordered from the provider, receipt of the presently unavailable product to take place after some degree of engineering or development, and after the product is made. (Note especially pages 6 and 7.)

Claims 34-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 34, as amended, recites providing a set of records, "wherein each of the unavailable products cannot be ordered from the seller." This is not supported by the specification, which only describes providing information on products which are not immediately available, but which can be ordered from the provider, receipt of the presently unavailable product to take place after some

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degree of engineering or development, and after the product is made. (Note especially pages 6 and 7.)

Claim 37 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 37, as amended, recites receiving a specification "for an unavailable product that cannot be ordered from a seller." This is not supported by the specification, which only describes selecting a product or attribute which is not immediately available, but which can be ordered from the provider, receipt of the presently unavailable product to take place after some degree of engineering or development, and after the product is made. (Note especially pages 6 and 7.)

Claims 39-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 39, as amended, recites allowing selection "of products/attributes that cannot be ordered from the provider." This is not supported by the specification, which only describes selecting a product or attribute which is not immediately available, but which can be ordered from the provider, receipt of the presently unavailable product to take place after some degree of engineering or development, and after the product is made. (Note especially pages 6 and 7.)

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 39-41 are not rejected under 35 U.S.C. 101, but Examiner wishes to make his interpretation of record. Claims 39-41 are viewed as reciting computer-implementable code stored in a computer-readable medium (the memory device), which, when executed by a computer, cause the computer to carry out operations.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 4, 12, and 13

Claims 1, 3, 4, 12, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by House et al. (U.S. Patent 6,785,805). As per claim 1, House discloses a method for providing custom-engineered products, the method comprising: providing an online catalog having an unavailable product/attribute selector to select an unavailable product or attribute that is not offered for sale, in the sense of not currently existing for sale (Abstract; column 2, line 48, through column 3, line 9; column 3, line 49, through

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column 4, line 4; column 4, line 41, through column 5, line 3; column 8, line 64, through column 9, line 36; column 10, lines 55-60; column 16, lines 14-27; column 29, lines 13-17); receiving a selection of an unavailable product attribute (column 4, lines 12-27; column 10, lines 55-60) that requires one or more of engineering and testing before it may be produced (column 4, lines 12-27; column 4, line 59, through column 5, line 3; column 11, lines 6-21).

As per claim 3, House discloses determining a resource cost for the unavailable product/attribute (column 4, lines 15-23).

As per claim 4, House discloses assigning a category of design requirements to the unavailable product/attribute (column 9, lines 30-36; column 12, lines 17-29).

As per claim 12, House discloses that the unavailable product/attribute selector comprises a list of unavailable products/attributes (column 9, lines 30-36; column 13, lines 38-48).

As per claim 13, the existence and availability of at least one such list (as in claim 12, above) inherently requires at least one item to have been classified in the list.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2, 5-11, and 14

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805) as applied to claim 1 above and further in view of Joseph (U.S. Patent 5,878,401). As per claim 2, House does not disclose suggesting an existing/standard product based upon and as a replacement for the selection, but Joseph teaches suggesting an existing/standard product based upon and as a replacement for the selection of an unavailable item (Abstract). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do this, for the obvious advantages of profiting from the sale of a recommended item, and saving the time needed to custom-manufacture an unavailable product.

Claims 5, 6, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805) as applied to claim 4 above and further in view of official notice. As per claim 5, House discloses determining a resource cost for the unavailable product/attribute (column 4, lines 15-23). House does not disclose

assigning a first category to the unavailable product attribute if the resource cost is relatively lower; and assigning a second category to the unavailable product attribute if the resource cost is relatively higher, but it is well known to assign categories to items based on cost. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to assign respective first and second categories based on lower or higher cost, for such obvious advantages as assigning priority to engineer and manufacture a product, or track the results of a business practice, for possible modification.

As per claims 6 and 7, House discloses transmitting a request to a manufacturing facility for the product/attribute if is assigned to a first category (whatever that category may be) (column 7, lines 44-46), and official notice is taken it is well known for transmissions to be transmissions to an appropriate address. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to transmit a request for the unavailable product/attribute to an address with the assigned category, for the obvious advantage of causing appropriate action to be taken regarding the product/attribute; and to transmit the request to a manufacturing facility, for the obvious advantage of causing the product to be manufactured.

As per claim 8, House not expressly disclose the request to an engineering department for the unavailable product/attribute, but does disclose that an unavailable product/attribute may require engineering services, and that orders are sent to the appropriate personnel or department for engineering services (column 4, lines 12-27;

column 4, line 59, through column 5, line 3; column 11, lines 6-21), and discloses transmitting information to a relevant department (column 7, lines 44-46). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to transmit the request to an engineering department if it is assigned to a second predefined category, for the obvious advantage of making the information readily available to the engineering department to perform the necessary engineering.

Claims 9, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805) as applied to claim 1 above and further in view of official notice. As per claim 9, House does not expressly disclose providing a list of available products in the online catalog, but official notice is taken that it is well known to provide lists of available products in online catalogs. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do this, for the obvious advantage of profiting from the sale of products already available and in stock.

As per claim 11, House discloses transmitting a request to a manufacturing facility (column 7, lines 44-46). Whether this is for receiving an order for an available product depends on the meaning of "available," in that House's products are ordinarily not already sitting in inventory, but are in some cases available to be manufactured from available parts without significant testing or engineering (column 2, lines 35-44; column 4, lines 28-40), and are therefore available by Applicant's definition (the instant application, page 3, lines 1-4; page 6, line 6, through page 8, line 2); moreover, if

“available” meant “already sitting on a shelf,” transmitting a request to a manufacturing facility would be less necessary. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant’s invention of providing available products to would-be purchasers.

As per claim 14, House does not expressly disclose that the unavailable product/attribute selector comprises an online form (although House’s disclosure regarding lists, menus, etc. could be read as implying an online form), but official notice is taken that it is well known to make catalog selections, etc., from an online form. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant’s invention for the unavailable product/attribute selector to comprise an online form, for the obvious advantage of enabling users to make selections in a standard manner likely to be familiar to users and to interface designers.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805) as applied to claim 1 above and further in view of Hunter et al. (U.S. Patent 6,850,901). House does not disclose obsoleting an available product by moving it from the list of available products to a list of unavailable products, but Hunter teaches updating the status of products from available to unavailable (column 9, lines 25-41), which may be in an online catalog (column 6, lines 5-12). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant’s invention to obsolete an available product by moving it from the list of available products to a list of unavailable products, for the obvious advantage of

informing shoppers which products are readily available, and which would require delay or custom manufacture, and profiting from resulting sales.

Claims 15-33

Claims 15, 16, 17, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805) in view of official notice. As per claim 15, House discloses a method for providing unavailable products/attributes and for operating an associated computer system (e.g., column 10, lines 41-55; column 11, line 56, through column 12, line 5) having at least one of each of the following: a memory (column 10, lines 41-55); a visual interface (e.g., column 3, lines 27-48; column 13, line 22, through column 14, line 16), and a user interface selection device interface (e.g., column 3, lines 27-48; column 13, line 22, through column 14, line 16). House does not expressly disclose a central processing unit, but servers such as House discloses are computers, and official notice is taken that it is well known for computers to have central processing units. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the server of House's disclosure to have at least one CPU, in communication with other parts of the system, for the obvious advantage of enabling it to carry out its disclosed functions.

House discloses that the method comprises: providing an unavailable product/attribute selector in the computer system (Abstract; column 2, line 48, through column 3, line 9; column 3, line 49, through column 4, line 4; column 9, lines 14-36; column 10, lines 55-60) to select one of a product and an attribute which that cannot be

ordered from the provider (*ibid.*; see also column 4, line 41, through column 5, line 3; column 8, line 64, through column 9, line 13; column 16, lines 14-27; column 29, lines 13-17). House does not expressly disclose displaying a list of available products, stored in a memory of the computer system, on a visual interface of the computer system (although this is strongly hinted at in column 2, lines 10-21), but official notice is taken that it is well known for merchants in e-commerce to display lists of available products, stored in a memory, on a visual interface. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do this, for the obvious advantage of profiting from the sale of such available products.

As per claim 16, House discloses storing a list of unavailable products/attributes (column 9, lines 30-36; column 13, lines 38-48).

As per claim 17, House discloses displaying the list of unavailable products/attributes on a visual interface of the computer system (column 13, line 38, through column 14, line 16).

As per claim 18, House discloses storing categories of design requirements associated with the unavailable products/attributes (column 4, lines 15-40).

As per claim 19, House discloses receiving a selection of an unavailable product/attribute via a selection signal from a user interface selection device (column 4, lines 12-17; column 10, lines 55-60; column 13, line 38, through column 14, line 16); and displaying a resource cost of the product on a visual interface of the computer system (column 10, lines 41-67).

As per claim 20, House discloses receiving a selection of an unavailable product/attribute via a selection signal from a user interface selection device of the computer system (Abstract; column 9, lines 30-36; column 13, line 22, through column 14, line 16); identifying one or more available products that have similar characteristics to those of the selected unavailable product/attribute; and displaying one or more available products on a visual interface of the computer system (column 7, lines 7-25). House does not expressly disclose identifying by a CPU of the computer system, but the CPU is obvious as set forth above regarding claim 15.

As per claim 21, House discloses generating a specification for a product in response to receiving a selection signal from the user interface selection device of an unavailable product/attribute (Abstract; column 13, line 38, through column 14, line 16).

As per claim 22, House discloses transmitting a signal representative of the specification (column 7, lines 7-25; column 7, lines 44-46). House does not expressly disclose that this is via electronic transmission, but official notice is taken that it is well known for transmission over the Internet or an intranet (see column 11, line 56, through column 12, line 5) to be electronic transmission. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for this to be via electronic transmission, for the obvious advantage of making the information readily available to a distant user.

As per claim 23, House discloses providing a list of resources in a memory of a computer system, and allocating the resources based, at least in part, upon the specification (column 4, lines 5-59; column 10, lines 41-55).

As per claim 24, House discloses, at least by implication, selecting an available product from a list that has similar characteristics to those of the specification (and displaying it) (column 7, lines 7-25); and House discloses identifying materials for costing purposes (column 4, lines 5-27).

As per claim 25, House discloses calculating a materials cost of base materials (column 4, lines 5-27), and a bill of materials (column 7, lines 39-43).

As per claim 26, House discloses transmitting assembly information (column 7, lines 44-46), which would typically include materials information, as above. House does not expressly disclose transmitting the signal via electronic transmission, but official notice is taken that it is well known for transmission over the Internet or an intranet (see column 11, line 56, through column 12, line 5) to be electronic transmission. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for this to be via electronic transmission, for the obvious advantage of making the information readily available to a distant user, manufacturing department, etc.

As per claim 27, House discloses, at least by implication, selecting an available product from a list that has similar characteristics to those of the specification (and displaying it) (column 7, lines 7-25). The selection process disclosed by House (e.g., column 9, lines 30-36; column 13, line 38, through column 14, line 16) involves determining a variance between a basic product, which may be already available, and a specified product which may have to be custom-engineered and manufactured.

As per claim 28, House discloses assigning a category of design requirements to the unavailable product/attribute (column 9, lines 30-36; column 12, lines 17-29), which may be considered to comprise assigning it to the variance.

As per claim 29, House discloses transmitting a signal representative of the specification to an address associated with the assigned category (column 7, lines 44-46). House does not expressly disclose transmitting the signal via electronic transmission, but official notice is taken that it is well known for transmission over the Internet or an intranet (see column 11, line 56, through column 12, line 5) to be electronic transmission. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for this to be via electronic transmission, for the obvious advantage of making the information readily available to a distant user, manufacturing department, etc.

As per claim 30, House discloses receiving a selection of an unavailable product/attribute via a selection signal from the user interface selection device (Abstract; column 9, lines 30-36; column 13, line 22, through column 14, line 16). House further discloses storing a resource cost heuristic; and calculating a resource cost for the unavailable product/attribute based on the selected unavailable product/attribute and the resource cost heuristic (column 4, lines 5-50; column 10, lines 41-64).

As per claim 31, House discloses receiving a selection of an unavailable product/attribute via a selection signal from a user interface selection device of the computer system (Abstract; column 9, lines 30-36; column 13, line 22, through column 14, line 16). House further discloses calculating a resource cost for the unavailable

product/attribute (column 4, lines 5-50; column 10, lines 41-64). House does not disclose comparing the resource cost to a list of available resources, and making an accept/reject decision, but official notice is taken that it is well known to compare costs to available resources, and to make accept/reject decisions. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do so, for the obvious advantage of attempting to make and sell products when, and only when, making and selling those products was feasible and profitable.

As per claim 33, House discloses a receiving a selection of an unavailable product/attribute via a selection signal from a user interface selection device of the computer system (Abstract; column 9, lines 30-36; column 13, line 22, through column 14, line 16). Transmission via electronic transmission is obvious as set forth above, regarding claim 29; House does not expressly disclose transmitting from the server system a signal representing a request for quotation, but does disclose determining a cost of components, and discloses that components may be from third parties (column 4, lines 5-27), and official notice is taken that it is well known to request quotations. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to transmit a request for quotation, for the obvious advantage of determining the cost of such a component, as well as obtaining components at the lowest cost.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over House and official notice as applied to claim 29 above, and further in view of Hunter et al. (U.S.

Patent 6,850,901). House does not disclose moving an item from a list of available products to a list of unavailable products, but Hunter teaches updating the status of products from available to unavailable (column 9, lines 25-41), which may be in an online catalog (column 6, lines 5-12). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to move an item by moving it from the list of available products to a list of unavailable products using a user selection device of the computer system, for the obvious advantage of informing shoppers which products are readily available, and which would require delay or custom manufacture, and profiting from resulting sales.

Claims 34-36

Claims 34, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805) in view of Hartman et al. (U.S. Patent 5,960,411) and official notice. As per claim 34, House discloses a method for offering products, comprising: providing a set of available product records, each available product record containing a specification for an associated product (column 9, lines 30-36); and providing a set of unavailable data records, each unavailable data record containing an allowed variance to an associated product (column 4, line 41, through column 5, line 3; column 8, line 64, through column 9, line 13; column 9, lines 30-36; column 10, lines 55-60; column 16, lines 14-27; column 29, lines 13-17; see also column 13, line 22, through column 14, line 16); displaying product data records on a visual display (column 13, line 22, through column 14, line 16), where at least some of the product records are for custom-engineered products, and are therefore unavailable,

while some of the basics products may well be available, official notice being taken that it is well known to have products already assembled and available; and House discloses receiving an input, via a user interface selection device, of a user selection from the set of unavailable product data records (Abstract; column 9, lines 30-36; column 13, line 22, through column 14, line 16). House is not much concerned with associated already available products that can be ordered from a seller without complications, but sets of such available products which can be ordered from a seller are well known, as taught, for example, by Hartman (column 1, lines 46-57). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for such products to be available to be ordered from a seller, for the obvious advantage of profiting from the sale of products already available and in stock.

As per claim 35, House discloses that at least one of the unavailable data records is a variance from a basic product data record (column 9, lines 30-36; column 13, line 22, through column 14, line 16), and official notice is taken, as above, that it is well known to have products already assembled and available.

As per claim 36, House does not expressly disclose that one of the unavailable data records represents an existing, but untested, product, but does disclose testing of products (e.g., column 4, lines 23-27), and official notice is taken that even a product which exists may not be salable if not tested, due to regulations requiring testing, or concerns about legal liability, or about selling only functioning and safe products. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for at least one of the unavailable data

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records to represent an existing, but untested, product, for the motivation stated above, and as a consequence of the time necessary to perform testing.

Claim 37

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805) in view of official notice. House discloses a method for offering custom products, comprising: receiving an input, via a user interface selection device, of a specification for an unavailable product that cannot be ordered from a seller (column 4, lines 12-27; column 4, line 41, through column 5, line 3; column 8, line 64, through column 9, line 13; column 10, lines 41-60; column 13, line 38, through column 14, line 16; column 16, lines 14-27; column 29, lines 13-17); executing a resource costing module to determine the resource cost for creating the unavailable product (column 3, lines 3-9; column 4, lines 15-27); and transmitting a price based on the resource cost (column 10, lines 65-67). House discloses a server which performs processing (column 11, line 56, through column 12, line 5). House does not expressly disclose that the price is transmitted from the processor via electronic transmission, but official notice is taken that it is well known for transmission over the Internet or an intranet (see column 11, line 56, through column 12, line 5) to be electronic transmission. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for this to be via electronic transmission, for the obvious advantage of making the information readily available to a distant user.

Claim 38

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805) in view of official notice. House discloses a method for offering products, comprising: providing a set of available product records, each available product record containing a specification for an associated product (column 9, lines 30-36); and providing a set of variance data records, each variance data record containing an allowed variance to an associated product (column 8, line 64, through column 9, line 13; column 9, lines 30-36); displaying product data records on a visual display (column 13, line 22, through column 14, line 16), where at least some of the product records are for custom-engineered products, therefore variable records, while some of the basics products may well be available, official notice being taken that it is well known to have products already assembled and available; and House discloses receiving an input, via a user interface selection device, of a user selection from the set of unavailable product data records (Abstract; column 9, lines 30-36; column 13, line 22, through column 14, line 16).

Claim 39-41

Claims 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over House et al. (U.S. Patent 6,785,805) in view of Hartman et al. (U.S. Patent 5,960,411) and official notice. As per claim 39, House discloses a computer-implemented process, implying a memory structure causing the computer(s) to carry out the disclosed process, and discloses: a computer retrieving stored information, implying a memory device (e.g., column 4, lines 15-23; column 10, lines 41-64); and an unavailable

product/attribute selector allowing selection of products/attributes not currently available from a given provider (Abstract; column 2, line 48, through column 3, line 9; column 3, line 49, through column 4, line 4; column 9, lines 14-36; column 10, lines 55-60). House does not expressly disclose an available product list implemented in memory, but does disclose lists of components (e.g., column 14, lines 24-32; column 20, lines 26-37) and components already available for assembling into previously unavailable products (column 2, lines 10-21; column 4, lines 28-40), these components being products. Official notice is taken that it is well known to maintain items in lists. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to implement in the memory an available product list, for the obvious advantage of easily accessing information on available components usable in assembling previously unavailable products.

House does not expressly disclose a read/write memory device, but discloses retrieving data from a database and adding feedback to the database (column 4, lines 15-23; column 10, lines 41-64), implying reading and writing to memory.

House is not much concerned with associated already available products that can be ordered from a given provider without complications, but sets of such available products which can be ordered from a provider are well known, as taught, for example, by Hartman (column 1, lines 46-57). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for such products to be available to be ordered from a given provider, for the obvious advantage of profiting from the sale of products already available and in stock.

As per claim 40, House discloses that the unavailable product/attribute selector can be an unavailable product/attribute list (column 9, lines 30-36; column 13, lines 38-48).

As per claim 41, House does not expressly disclose that the unavailable product/attribute selector comprises an online form (although House's disclosure regarding lists, menus, etc. could be read as implying an online form), but official notice is taken that it is well known to make catalog selections, etc., from an online form. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the unavailable product/attribute selector to comprise an online form, for the obvious advantage of enabling users to make selections in a standard manner likely to be familiar to users and to interface designers.

(Claim 41 is treated as depending on claim 39, based on its recitation of "the memory structure" rather than "The method," and further, "the unavailable product/attribute selector," although it says, "The memory structure of claim 38". The prior version of claim 41 depended on claim 39, and claim 41 is characterized as "original" rather than "currently amended," so the reference to claim 38 is presumed to be a mere typographical error.)

Response to Arguments

Applicant's arguments filed October 6, 2005 have been fully considered but they are not persuasive. Applicant writes that claim 1 has been amended to clarify what is

meant by “unavailable,” defining it by “an unavailable product or attribute that is not offered for sale.” Examiner replies that this only muddies the matter, rather than clarifying it. One can interpret an unavailable product not offered for sale in two relevant ways. According to the first interpretation, a vendor says, “We don’t have it for sale, and we cannot or will not attempt to obtain it. If you really want it, find another vendor, or try to manufacture it yourself.” According to the second interpretation, the vendor says, “We don’t have it available now, but we can do some engineering and development, manufacture it to your specifications, and then sell it to you.” According to the second interpretation, claim 1 and some other claims are anticipated by House et al., and the remaining claims are obvious over House et al. According to the first interpretation, support for claim 1 is lacking in the specification, making the claim properly rejectable under 35 U.S. 112, first paragraph; furthermore, it is unclear why one would “transmit the request to a manufacturing facility for the unavailable product/attribute,” as recited in claim 8, if one has no intention of manufacturing the unavailable product for sale.

Applicant argues that House does not teach or suggest that any of the products selected via its network build-to-order system are not offered for sale. If “not available for sale” is given the first interpretation, this may be true, but then there is the §112 problem. If “not available for sale” is given the second interpretation, then products selected via the system of House are sometimes not offered as currently available for sale, but are to be sold after appropriate engineering and development (see House: column 4, line 41, through column 5, line 3; column 8, line 64, through column 9, line 13; column 16, lines 14-27; column 29, lines 13-17).

The other independent claims (excepting claim 38, which is simply rejected over the prior art, but not under §112) pose similar dilemmas. Either they are absurdities not properly supported by the specification, or they are obvious over House, sometimes in combination with other prior art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tracy et al. (U.S. Patent 5,979,757) disclose a method and system for presenting item information using a portable data terminal. Schneier et al. (U.S. Patent 6,099,408) disclose a method and apparatus for securing electronic games. Knowles et al. (U.S. Patent 6,182,897) disclose a web-enabled system and method for designing and manufacturing laser scanners. Cohen (U.S. Patent 6,278,963) discloses a system architecture for distribution of discrete-event simulations. Fujiwara (U.S. Patent Application Publication 2001/0032149) discloses a method, system, and apparatus for effecting electronic commercial transactions. Montoya (U.S. Patent Application Publication 2001/0047292) discloses a method and system for collecting and disseminating survey data over the Internet.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-272-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER

December 13, 2005